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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/933,284

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Gregory P. Fitzpatrick

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05/18/2007

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EXAMINER

CASLER, TRACI

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

05/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/933,284

Applicant(s)

FITZPATRICK ET AL.

Examiner

Traci L. Casler

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on 28 February 2007.

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-6, 10-13, 25-30, 34-37, 49 and 50 is/are pending in the application.

4a) Of the above claim(s) 20-22 and 44-46 is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-6, 10-13, 25-30, 34-37 and 49-50 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☒ Claim(s) 20-22 and 44-46 are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5) ☐ Notice of Informal Patent Application

6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is in response to papers filed on February 28, 2007.

~~Claims~~ 1, 10, 20, 25, 34 and 44 have been amended.

Claims 20-22 and 44-46 have been withdrawn.

Claims 1-6, 10-13, 25-30, 34-37, and 49-50 are pending.

### ***Election/Restrictions***

1. Newly submitted claims 20-22 and 44-46 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The claims are now amended to identify comparison and notification to be sent without the use of the central server as required by the other claim groupings. The removal or lack of central server requirement therefore is directed to a separate invention. As applicant points out in argument of claims 20-44 separately on pg. 15 of response dated February 28, 2007 "Claims 20 and 44 recite the comparison of contacts lists and generation of one or more messages between a first and second PCD can occur locally without having to access a remote server or infrastructure. All other groups of claims require accessing the central server(clearing house) to make a comparison of contacts and the clearing house/central server sends the notification of common contacts not the PCD's.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 20-22 and 44-46 are withdrawn from

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consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

***Claim Rejections - 35 USC § 103***

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2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 1-2, 4-6, 10-13, 25-26, 28-30, 34-37 and 49-50 rejected under 35 U.S.C. 103(a) as being obvious over US Patent 6,539,232; Method and System for Connecting mobile users based on degree of separation. Hendrey et al, in view of non-patent literature "Personal Area Networks: Near-field intrabody communication"; IBM Systems Journal; 1996 Zimmerman.
4. As to claims **1, 10, 17, 25, 34** Hendrey teaches:
- Receiving communication from one portable device to another(C.5 I. 8 & 28).
- Receiving a communication at a central station from a device
- identifying common contacts between users of two devices(C. 5 I. 40-50)
- establishing a communication between to the two devices identifying they have a common contact(C. 2 I. 53-54 C. 19 I. 60-63). Hendrey fails to explicitly teach actually sending a message via the established communication. However, it would have been obvious to one skill in the art at the time of invention to combine this limitation with Hendrey. Hendrey identifies the prior art telecommunication uses for sending messages to pagers(C. 1 I. 61-65) in which it would be obvious to send messages with the communications established my Hendrey's invention.
- Hendrey fails to teach the providing an identifier that identifies the second user. However, Zimmerman teaches a sharing contact information to share information of two people(Pg. 8 Par. 1-2). It would have been**

obvious to one skilled in the art at the time of invention to combine Zimmerman with Hendrey as Zimmerman states it increases the usefulness of sharing information by giving additional features not provided by other independent devices.

**Hendrey fails to teach the communication between the device's as a direct communication.** However, Zimmerman teaches direct communication of PDA's via an infrared and or radio frequency communication(Pg. 2 ¶ 2-4) It would have been obvious to one of ordinary skill to combine Zimmer with Hendrey as Zimmerman identifies the capabilities of autonomous yet interconnected devices....as wireless ports become more common ...offering alternatives to congesting the airwaves with data.

5. As to claims 2, 11-12, 26 and 35-36 Hendrey teaches identifying the two users in later correspondence(C. 10 I. 40-43 and 51)
6. As to claims 4-5 and 28-29Hendry teaches notification sent to devices telling user another user is identified with a common contact(C. 20 I. 1-5)
7. As to claims 6, 13, 18-19, 30, 37 Hendrey teaches the identifier being visually displayed either in text, graphical form.(C. 4 I. 12-15).
8. As to claim 50 Hendrey fails to teach the message with a symbol. However, Zimmerman teaches sending contact information Pg. 8 ¶ 12). It would have been obvious to combine Hendrey with Zimmerman for the symbol as a symbol can be determined as a letter, number graphic etc. Therefore the limitation of the identifier is being a symbol is considered non-functional descriptive material. The steps of the

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method/process will be performed the same regardless of what type of information is being displayed and/or how the message is being displayed.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 3 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,539,232; Method and System for Connecting mobile users based on degree of separation. Hendrey et al.

As to claims 3 and 27 Hendrey teaches a method of identifying common contacts among mobile device users. However, Hendrey fails to teach identifying the common contact in a communication to the users. It would have been obvious to one of ordinary skill in the art at the time of invention to identify to the users what the commonality is so

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the users are aware of how they are receiving this communication and it's safe to communicate back. Hendrey identifies the users setting the "degrees of separation" for which one qualifies to have information sent, there for user meeting a second user or receiving information would want to know how this person is connected to them. What type o relationship is there between them and the second user.

### ***Response to Arguments***

4. Applicant's arguments filed February 28, 2007 have been fully considered but they are not persuasive. Applicants arguments are all directed to the "direct" communication of the first and second device in which examiner has address with the art rejection above. Furthermore, the applicant argues limitations of claim from with have been withdrawn as part of the election by original presentation.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the



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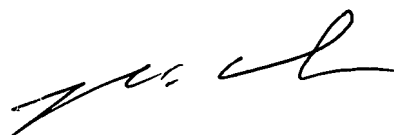
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Casler whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TLC  


  
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